

## **REMARKS**

Claims 1-3, originally filed with the application, were previously cancelled. Claims 4-33 were added by preliminary amendment. Dependent claims 34-53 have been by this amended. With the addition of claims 34-53, claims 4-53 are presented herewith for consideration.

### **PROVISIONAL DOUBLE PATENTING REJECTION**

Claims 4-33 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-38 of copending Application No. 10/748,482. Applicants respectfully traverse. Co-pending application no. 10/748,482 is directed to an educational toy having a housing containing a speaker and processor and supporting the work platform required for operation of the toy. In contrast, the present invention is directed to a portable memory device for delivering educational content to the educational toy. These are patentably distinct inventions. Applicants request withdrawal of the provisional double patenting rejection.

### **OBVIOUSNESS UNDER 35 U.S.C. S 103**

Claims 4-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,088,928 to Chan ("Chan") in view of U.S. Patent No. 5,681,170 to Rieber et al. ("Rieber"). Applicants respectfully traverse the rejection as follows.

The former Examiner failed to indicate any teaching in Chan or Rieber corresponding to the first three elements of each of the independent claims – *i.e.*, a portable memory housing designed to be compatible with and inserted into a portable memory receiving device associated with the electronic toy by the user thereof; a memory medium contained in the portable memory housing; and computer software embodied on the memory medium for use with a toy

processor in the educational toy. Without a showing of these elements in the cited references, the claims cannot be considered obvious over those references.

Additionally, the former Examiner also conceded that, "Chan does not appear to disclose audio questioning." See May 24, 2004 Office Action at ¶ 4. However, at ¶¶ 6-8, the former Examiner asserted that Rieber teaches the use of audio synthesis for questioning and that it would have been obvious to one of ordinary skill in the art that the Chan device use audio questioning as taught by Rieber.

However, the former Examiner ignores the fact that Chan expressly teaches away from any combination with Rieber. Chan repeatedly discusses the benefits (*i.e.*, low cost and simple to manufacture) of combining a separate touch-sensitive surface with a separate computer. Chan states:

This invention provides a **low-cost apparatus** with standard game-port interface to commonly known personal computer systems, and enables users, especially children to play computerized programmable education games with finger pointing. The printer matter contains no bores. The touch area is large and thus does not require precision pointing. The touch pad is self-contained with no external interface electronics, and consists of only two layers. There are two additional non-position sensing touch switches for start, reset, clear and/or player A and B move identification. **Thus, it is easy to use, reliable, and inexpensive to manufacture.**

The present invention combines the advantages of both the conventional educational game and those of the computer video game without their inherent disadvantages of using a keyboard, a joystick or a precision pointing touch-sensing apparatus for input by small children. Briefly, a game apparatus according to this invention, includes: a set of printed cards/boards, a novel low-cost touch sensitive pad, an interface cable to the computer game-port, and a computer program corresponding to the said set of printed cards/boards. **Thus, this programmable educational board game apparatus, according to this invention can be produced at a very low cost for the consumer market.**

**Another objective of this invention is to provide a low-cost general-purpose boardgame apparatus for one or more players**

with standard game-port interface to commonly known personal computer systems, and enables users, especially children to play computerized programmable board games with a variety of gameboards and moving-game pieces... . Again, the touch pad is self-contained with no external interface electronics, and consists of only two layers. There are two additional non-position sensing touch switches for start, reset, clear and/or player A and B move identification. **Thus, this board game apparatus is fun to use, reliable, versatile and inexpensive.**

As will become apparent, the computerized educational games and board games apparatus incorporating the invention are, relative to the educational/board games on the market, are much more versatile, **but still inexpensive to manufacture due to the novel construction of the touch pad and its interface to the game-port of the personal computer system.**

It would have been contrary to the low-cost approach of Chan to include a speaker for generating audio prompts and a processor in the toy housing. One of average skill in the art would clearly have recognized that this would have defeated the design goals of Chan. Thus, the skilled artisan would read Chan to teach away from its combination with Rieber.

The law is clear that references that teach away cannot serve to create a *prima facie* case of obviousness. *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001) *citing In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Even where the cited references are combined, applicants respectfully submit that the combination does not teach or suggest the invention recited in the claims. As set forth hereinafter in the next section, the claims of the present invention have been amended to clarify features of the invention which are nowhere found in the cited references, taken alone or in combination with each other.

### **AMENDMENTS TO THE CLAIMS**

Applicants respectfully submit that the claims as originally-filed fully distinguish over the prior art and are patentable thereover. Notwithstanding, Applicants have amended the claims to

further clarify the invention relative to the prior art. Each of the independent claims recites that the one or more sensors are capable of “sensing the location of a first contact caused by the child on the planar surface of the work platform and, while the first contact is maintained in position to be sensed by the sensing system, sensing the location of a second contact caused by the child on the planar surface of work platform.” Chan nowhere teaches, discloses or suggests sensors capable of sensing the locations of two or more coexisting child-caused contacts with the work platform. Chan’s resistance based touch pad apparatus cannot determine the locations of two or more coexisting child-caused contacts with the touch pad. Two or more contacts would cause erroneous terminal resistance values  $R_{x8}$  and  $R_{y9}$  (see col. 4 through col. 7, line 11), and therefore cause erroneous location determinations. This is further confirmed by the description corresponding to Fig. 5 at col. 8, lines 18-23. The board game does not allow two or more co-existing contacts with the touch pad. Instead, a player is required to “press down on the game board 16” with the moving game piece to register a move. The touch pad of Chan does not detect a released game piece. Thus, Chan relies upon the child to press down at a singular location on the game board to register a move because it is unable to sense the location of two or more co-existing contacts with its touch pad.

Touch sensitive surface has been broadened to work platform in the independent claims. The dependent claims narrow the work platform to a touch-sensitive surface in new claims 35, 39, 43, 47 and 51.

An invention as recited including the above limitations is nowhere disclosed, taught or in any suggested in the prior art, whether taken alone or in combination with each other. It is therefore

respectfully requested that the rejection on these grounds be withdrawn. All of the dependent claims are allowable for at least the reasons stated above.

#### NEW CLAIMS

Applicants have added new claims 34-53. Each of these claims is dependent on one of claims 4-33 discussed above and patentable for at least the reasons set forth above. No new matter has been added.

Based on the above amendments and remarks, reconsideration of Claims 4-33, and consideration of Claims 34-53 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, November 24, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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